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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,122	02/15/2002	Herbert Peiffer	01/026 MFE	2899

7590

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EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/077,122

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Claim Objections*

1. Claims 8-9 are objected to because of the following informalities: the claims contain typographical errors with the degree signs (°) being replaced by boxes (□). Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/077,454 in view of ULLMANN'S ENCYCLOPEDIA OF INDUSTRIAL CHEMISTRY (hereinafter ULLMANN'S).

Application No. 10/077,454 claims a transparent, biaxially oriented film with the recited particle contents, optical and surface properties, orientation characteristics, method of orienting

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and heat-setting, post-treatment, and use of recycled material. However, the Application does not explicitly claim a multilayer film.

ULLMANN'S discloses that it is well known in the art to combine multiple polymer films and functional coatings to form multilayer films in order to allow optimization of mechanical, sealing, barrier, and other physical properties (sections 2.4.2-2.4.3 and 6.13), wherein the multilayer films are formed by conventional methods such as coextrusion.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the film layer claimed in Application No. 10/077,454 into multilayer film structures containing an additional polyester layer and optionally another functional coating layer as suggested by ULLMANN'S in order to tailor the mechanical, adhesion, heat-sealing, and other physical properties of the laminate for a specific application. One of ordinary skill in the art would have selected the appropriate thicknesses of the surface or coating layers as indicated in claim 4 depending on the specific type of materials used in the layer and the particular property-enhancing function of said layers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 103***

4. The rejection under 35 USC 103(a) based in SATO ET AL in the previous Office Action has been withdrawn in view of Applicant's amendments and arguments filed 4/10/2003.

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5. Claims 1-5, 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over PEIFFER ET AL (US 5,955,181) in view of KATOH ET AL (US 4,818,581) or HASEGAWA ET AL (US 5,077,118).

PEIFFER ET AL '181 discloses a transparent biaxially oriented multilayer polyester film suitable for packaging and/or metallization applications wherein the film comprises a base layer and at least one surface layer, said layers having the recited thicknesses, gloss, and haze values (lines 10-45, col. 7; Table 2), wherein one outer layer contains a first type of particle, the first type being present in typical amounts of 0.1 wt% and having a typical particle diameter of 2.5 microns (Example 10) (corresponding to the recited "pigment system") as recited in claims 1-2, 4-5, and a second type of particle. The reference further discloses the method and conditions of forming the biaxially oriented polyester film as recited in claims 8-9, the recited surface treatment as recited in claim 10, and the recited use of 20-50 wt% of recycled scrap material in the film as recited in claim 11 (line 45, col. 7 to line 35, col. 8). However, the reference does not explicitly disclose the recited particle size distribution.

KATOH ET AL and HASEGAWA ET AL each disclose that it is well known in the art to use particles having a narrow particle size distribution in polyester films in order to obtain uniformity in surface topography and improved slip properties. (KATOH ET AL, line 55, col. 4 to line 30, col. 5) (HASEGAWA ET AL, line 62, col. 5 to line 25, col. 6)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to minimize the variation in size of antiblocking particles as disclosed in KATOH ET AL or HASEGAWA ET AL in the films of PEIFFER ET AL '181 in order to obtain laminate films with uniform, controllable surface and film handling properties. One of ordinary

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skill in the art would have utilized or adapted the disclosed films for other well known film or packaging-related applications as indicated in claim 13. The "consisting essentially of" language in the present claims only restricts the physical structure of one collection or type of particle (i.e., the recited "pigment system"), but does not restrict the composition of the film as a whole; therefore, the invention as presently claimed does not preclude the presence of additional types of particles as the second type of particle used in the PEIFFER ET AL '181 films. The Examiner has reason to believe that the particle size distributions disclosed in KATOH ET AL or HASEGAWA ET AL are comparable to the spread in grain size distribution recited in claims 1, 3, therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

June 26, 2003



Vivian Chen  
Primary Examiner  
Art Unit 1773